HAROLD J. McELHINNY (CA SBN 66781)
RACHEL KREVANS (CA SBN 116421)
MATTHEW I. KREEGER (CA SBN 153793)
JASON A. CROTTY (CA SBN 196036)
DAVID M. HYMAS (CA SBN 226202)
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: 415.268.7000
Facsimile: 415.268.7522
hmcelhinny@mofo.com
rkrevans@mofo.com
mkreeger@mofo.com
jcrotty@mofo.com
dhymas@mofo.com

Attorneys for Defendants
ECHOSTAR SATELLITE LLC AND
ECHOSTAR TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05-CV-1114 JW **SATELLITE DEFENDANTS' BRIEF IN RESPONSE TO COURT'S OCTOBER 19 MARKMAN V ORDER** Date: N/A Time: N/A Courtroom: 8, 4th Floor Judge: Hon. James Ware

Dockets.Justia.com

INTRODUCTION

The Court's October 19, 2007, *Markman* V order requested additional briefing on the construction of "transmission system" and "receiving system." The Satellite Defendants[1] respectfully submit that whatever meaning of "transmission system" and "receiving system" the Court adopts, those constructions should be consistent across all of the claims of the Yurt patents.

I. THE TERMS "TRANSMISSION SYSTEM" AND "RECEIVING SYSTEM" SHOULD BE CONSTRUED CONSISTENTLY ACROSS ALL CLAIMS AND PATENTS.

Courts "are obliged to construe [the same term] consistently throughout the claims." *CVI/Beta Ventures v. Tura LP*, 112 F.3d 1146, 1159 (Fed. Cir. 1997); *see also Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001) ("[A] claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent."); *Southwall Techs. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995) ("[A term] cannot be interpreted differently in different claims because claim terms must be interpreted consistently."). So too must constructions be consistent across patents that share a common ancestry and common claim terms. *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005) ("Because NTP's patents all derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents.").

In *Southwall Technologies*, for example, the parties disputed the meaning of the term "sputter-deposited dielectric." 54 F.3d at 1575. The district court found that the patent's intrinsic record limited the term to a "one-step" process. *Id*. at 1577-78. On appeal, the Plaintiff argued that the district court erred in not considering that "in some claim combinations, the two-step process would not be literally covered by the claims, while in other claim combinations, the claim may be patentable for other reasons and literally cover a two-step dielectric process." *Id*. at 1578. Thus, the Plaintiff argued that the "dielectric" term could not be limited to a one-step process

[1] The Satellite Defendants are EchoStar Satellite LLC, EchoStar Technologies Corp., and the DIRECTV Group, Inc.

because some claim elements required a two-step process. The Federal Circuit rejected this approach:

> "Sputter-deposited dielectric" cannot be interpreted differently in different claims because claim terms *must be interpreted consistently*. Interpretation of a disputed claim term requires reference not only to the specification and prosecution history, but also to other claims. The fact that we must look to other claims using the same term when interpreting a term in an asserted claim *mandates that the term be interpreted consistently in all claims*.

Id. at 1579 (emphasis added and citations omitted).

Only where the specification and prosecution history *clearly* give a term different meanings in different claims may courts assign different constructions to the same claim term. *Fin Control Sys. Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1318 (Fed. Cir. 2001); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1311 (Fed. Cir. 1999). Here, there is nothing in either the specification or the prosecution history that indicates the patentees used different meanings for either "transmission system" or "receiving system" in the context of a particular claim. Therefore, the presumption that courts must give like claim terms the same constructions across all claims and patents applies.

Dated: November 2, 2007

MORRISON & FOERSTER LLP

By: /s/ Matthew I. Kreeger
Matthew I. Kreeger

Harold J. McElhinny
Rachel Krevans
Matthew I. Kreeger
Jason A. Crotty
David M. Hymas

Attorneys for Defendants
ECHOSTAR SATELLITE LLC and
ECHOSTAR TECHNOLOGIES CORP.